

## REMARKS

1. In paragraph 1 of the Office Action, the Examiner requested that the specification be amended to include the headings and subheadings specified therein. Accordingly, the specification has been amended to include the headings and subheadings specified by the Examiner.

2. In paragraph 2 of the Office Action, the Examiner objected to the disclosure finding an informality on page 2 of the October 4, 2004, amendment wherein page 5 of the specification was amended. In accordance with the Examiner's objection, the specification has been amended to change the phrase "The guides (27)" to "The guides 27."

3-4. In paragraphs 3-4 of the Office Action, the Examiner rejected Claims 1 and 4-6 under 35 U.S.C. § 103(a), as being unpatentable over EP 1136205 in view of Klingel (U.S. 5,605,492). According to the Examiner, EP 1136205 teaches the elements of these claims but does not disclose the cutting head of the present invention. According to the Examiner, Klingel teaches a cutting head that comprises a cutting nozzle (25) that is rotatably mounted (33) on a portal structure (34) and that the cutting nozzle (25) is rotatably mounted (35) on an arm (36) which is rotatable around a pin (30) that is integral with the portal structure. Therefore, according to the Examiner, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided EP 1136205 with a cutting head, as taught by Klingel, to allow for a more precise cutting apparatus.

Reconsideration is requested.

Although patent application EP 1136205 (also filed by Applicant) discloses the claimed parts of the present invention used to move the logs towards the cutter, it does not disclose the cutting head of the present invention. For example, one distinct

difference between the cutting head of EP 1136205 and that of the present invention is that EP 1136205 uses blades whereas the present invention uses a cutting nozzle. Klingel does not cure this defect.

As a preliminary matter, Klingel concerns an apparatus for placing straight or curved cuts in sheet metal work pieces and does not mention any work piece other than sheet metal. Klingel does not mention the multiple cutting-off of rolls of kitchen and/or toilet paper from logs as specified in claim 1. Accordingly, there would be no motivation for one skilled in the art to combine Klingel with EP 1136205. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (references may only be combined where there is some objective teaching in the prior art would lead one of ordinary skill in the art to combine the relevant teachings of the references); *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991) (it is impermissible to use the claimed invention as a template or instructional manual to piece together the teachings of the prior art so that the claimed invention is rendered obvious).

Equally important, the cutting head of Klingel does not render the present invention obvious. The cutting nozzle identified by the Examiner uniformly discloses that it is to be connected to, and used in cooperation with, a second cutting unit. The function of one of the nozzles is to make an initial cut that is followed by a second cut by the second nozzle at the same location of the work piece (col. 5, lines 34–64 and Fig. 2). In contrast, the present invention employs only one cutting nozzle and operates to provide transverse cuts on the logs.

In addition, the cutting nozzle 25 of Klingel identified by the Examiner is identified by Klingel as a cutting unit and it is positioned in an arm that is adjusted around a pin 35 that is mounted on holder 36 on another cutting unit 24. Thus, the cut that the nozzle makes is at an angle to the direction of the main cut. Klingel in Fig. 2

shows movement takes place along the direction of double arrows 39, 41, 33 and 40.

None of these directions will achieve transverse cutting of least two logs of paper . In contrast, the cutting nozzle of the present invention does not cut the log at such an angle and provides a transverse cut. Also, the Klingel cutting nozzle identified by the Examiner is positioned in a different kind of arm and in a different manner than is the cutting nozzle of the present invention. *Compare* Klingel Fig. 2 with Applicant's Fig. 1. Unlike the present invention, the Klingel arm is not shaped like an "L" and does not have a horizontal part like that of an "L" to hold the nozzle. As Klingel discloses, it is the very particular positioning of the Klingel cutting nozzle that allows it to move in-and-out and left-and-right by means of a spindle drive and a holder (col. 5 lines 47-50). This very different arm and positioning of the cutting nozzle on it teaches away from the present invention. That is, one skilled in the art following Klingel would clearly be led in a direction divergent from the path taken by the Applicant. *In re: Gurley*, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994). As the Examiner is aware, combining references is especially inappropriate where the prior art teaches away from the invention under consideration. *Ecolochem, Inc. v. Southern California Edison*, 227 F.3d 1361 (Fed. Cir. 2000).

Claim 1 requires that that the cutting head must cut at least two logs transversely and that the cutting nozzle is rotatably mounted on a portal structure. This apparatus is not suggested by Klingel because Klingel teaches that the cutting head 21 *with* the two separate cutting units is moved along the rail 34 over the work piece in direction 22 (col.5, lines 34-38). This type of cutting does not use a conveyor feed and the cutting is not achieved by rotation of the cutting head. Thus the Klingel device can not be used for transverse cutting according the recitation of claim 1 and for this reason, there is no basis on which to combine Klingel with the teachings of EP

1136205. Based on the foregoing, the combined teachings of the cited references do not render the present invention obvious.

5. In paragraph 5 of the Office Action, the Examiner rejected Claims 2 and 3 under 35 U.S.C. § 103(a), as being unpatentable over EP 1136205 in view of Klingel as applied to Claim 1, and further in view of Erickson et al., United States Patent No. 6,634,928 (“Erickson”). According to the Examiner, EP 1136205 and Klingel disclose the claimed invention except that the portal structure is movable forwards and backwards with respect to the bed as claimed. The Examiner finds the missing element in Erickson.

For the reasons explained above, the present invention is patentable over EP 1136205 in view of Klingel. Accordingly, regardless whether Erickson teaches a movable portal, it cannot be combined with the other references to render the present invention obvious. Even if such were the case (and it is not), one skilled in the art would have no motivation to combine Erickson with the noted references because Erickson concerns a device for cutting an object for use in a computer storage device from a ceramic or glass sheet (col. 1, lines 11-18). There is no suggestion therein that the device can be applied to making kitchen and/or toilet paper rolls. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (references may only be combined where there is some objective teaching in the prior art would lead one of ordinary skill in the art to combine the relevant teachings of the references); *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991) (it is impermissible to use the claimed invention as a template or instructional manual to piece together the teachings of the prior art so that the claimed invention is rendered obvious).

6. In paragraph 6 of the Office Action, the Examiner rejected Claim 7 under 35 U.S.C. § 103(a), as being unpatentable over EP 1136205 in view of Klingel as applied

to Claim 1, and further in view of Rudy, United States Patent No. 5,365,816 (“Rudy”). According to the Examiner, EP 1136205 and Klingel disclose the present invention except the at least one guide integral and located below the bed. The Examiner finds this element in Rudy. Again, the present invention is patentable over EP 1136205 in view of Klingel and Rudy does not cure the defects. Even if such were the case (and it is not), one skilled in the art would have no motivation to combine the references because Rudy concerns cutting pie shapes and wedges from food products (col. 1, lines 5-9). There is no suggestion therein that the device can be applied to make transverse cuts to kitchen and/or toilet paper logs to create rolls for distribution.

*Id.*

7. In paragraph 7 of the Office Action, the Examiner stated that Applicant’s prior arguments were mooted in light of the new grounds for rejections. Applicant notes this statement.

Early and favorable action is earnestly solicited.

Respectfully submitted,



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